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09/893,931	06/28/2001	Masahide Hio	FP01-003US	5384

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EXAMINER

GUSHI, ROSS N

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 14

Application Number: 09/893,931
Filing Date: June 28, 2001
Appellant(s): HIO ET AL.

Gerald Hespos
For Appellant

EXAMINER'S ANSWER

MAILED
FEB 25 2003
GROUP 2800

This is in response to the appeal brief filed 12/9/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The examiner agrees with Appellant's grouping of the claims.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5934928	Endo et al.	8/99
4040702	McKee et al.	8/77
3867005	Hoppe, Jr.	2/75

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe, Jr., ("Hoppe") in view of Endo et al. '928 ("Endo") and McKee et al. ("McKee"). Hoppe discloses an insulation-displacement terminal fitting (16), comprising: a base wall 54, first and second opposed side walls (53, 52) projecting from opposite sides of the base wall and defining a wire-receiving space between the side walls, each said side wall being provided with at least one V-shaped insulation-displacement portion (96, 97) projecting into the wire receiving space, at least first and second locks (99, 100) projecting into the wire-receiving space in a position spaced from the insulation displacement portions, aligned substantially normal to the side walls, whereby a wire (24) can be inserted into the wire-receiving space sufficiently for cutting a resin coating of the wire by projecting ends of the insulation-displacement portions and bringing a core of the wire into contact with the projecting ends of the insulation-displacement portions, and wherein the lock (99, 100) bites into at least the resin coating.

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In Hoppe, the locks are not shown as being substantially planar. McKee discloses an insulation displacement terminal including first and second substantially planar locks (see attachment) projecting from the sidewalls. McKee does not discuss the locks. Endo discusses the well known proposition that wire locks are for securing the wire in the terminal to prevent various pulling forces from pulling the wire out of the terminal (Endo col. 7, lines 45-50, col. 8, lines 1-10). At the time of the invention, it would have been obvious to modify the Hoppe locks as desired to have a configuration suitable for preventing unwanted separation between the terminal and the wire, including a substantially planar configuration as taught in Endo and McKee. The suggestion or motivation for doing so would have been to prevent unwanted separation between the terminal and the wire as taught implicitly in McKee and explicitly in Endo.

Per claim 12, the Hoppe locks project by a sufficient distance for contacting the core.

Per claim 13, the Hoppe locks and insulation displacement portions project substantially equal distances.

Regarding claim 14, the Hoppe terminal includes engaging portion 26, insulation displacement portions rearward of the engaging portions and locks 99 and 100 at the rear of the terminal.

(11) Response to Argument

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

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F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues regarding Hoppe that Hoppe portions 99 and 100 are not substantially planar. The examiner agrees with this and submits that this is the reason the rejection was based on 35 USC 103 as opposed to 35 USC 102.

Appellant argues that Hoppe does not suggest substantially planar locks (Appellant's Brief, pages 4-5). However, the examiner did not rely on Hoppe for suggesting substantially planar locks.

Regarding McKee, Appellant argues that because of the locks' orientation, the identified locks in McKee will have no effect where longitudinal forces exerted on the wire (Appellant's Brief, pages 5-6). However, the examiner has not suggested that the orientation locks 99 and 100 in Hoppe should be modified. The examiner's proposed modification would leave the orientation of the locks the same, where they would resist longitudinal forces on the wire.

Regarding Endo, Appellant argues that Endo has various teachings regarding plated portions of the blade contacting the wire (Appellant's Brief, page 8, first paragraph). These teachings in Endo are not particularly pertinent to the rejection presented above. Endo is relied on for the proposition that substantially planar wire locks are good for securing the wire in the terminal to prevent various pulling forces from pulling the wire out of the terminal (Endo col. 7, lines 45-50, col. 8, lines 1-10).

Regarding the 35 USC 103 rejection, Appellant argues that because Hoppe discloses benefits of using V-shaped insulation displacement portions, it

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teaches away from using planar locks. (Appellant's Brief, page 8, third paragraph). The examiner disagrees. Extolling the virtues one structure does not teach away from the addition of a different structure. In re Dance, 48 USPQ.2d. 1635 (Ct. App. Fed. Cir. 1998). Hoppe does not teach away from using planar locks merely by discussing certain advantages of V-shaped locks.

Appellant argues that the disclosures of Endo and Hoppe teach away from each other. (Appellant's Brief, page 8, fourth paragraph; page 9, third paragraph; page 11). The examiner disagrees. Extolling the virtues of one structure does not teach away from the addition of a different structure. In re Dance, 48 USPQ.2d. 1635 (Ct. App. Fed. Cir. 1998). Hoppe does not teach away from using planar locks merely by discussing certain advantages of V-shaped locks. Endo does not teach away from using V-shaped locks merely by discussing certain advantages of planar locks. Furthermore, McKee demonstrates that the proposed combination of planar locks combined with v-shaped locks is a known and useful combination.

Appellant argues that McKee is not considered to add anything relevant. (Appellant's Brief, page 9, second paragraph). The examiner disagrees. McKee discloses, among other things, the feasibility and usefulness of using of both v-shaped insulation displacement portions and planar locks.

Appellant argues that none of the references disclose or suggest "first and second planar locks . . . sidewalls" (where Appellant merely repeats the claim language, appellant's brief, page 9, paragraph 4, page 10, paragraph 2). The examiner responds that the rejection was based on 35 USC 103, not 35 USC

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103, and the examiner has not suggested that any one reference disclose every claimed limitation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (Appellant's Brief, page 10, second paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the ^{appellant's} ~~applicant's~~ disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

February 6, 2003

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FIG. 1

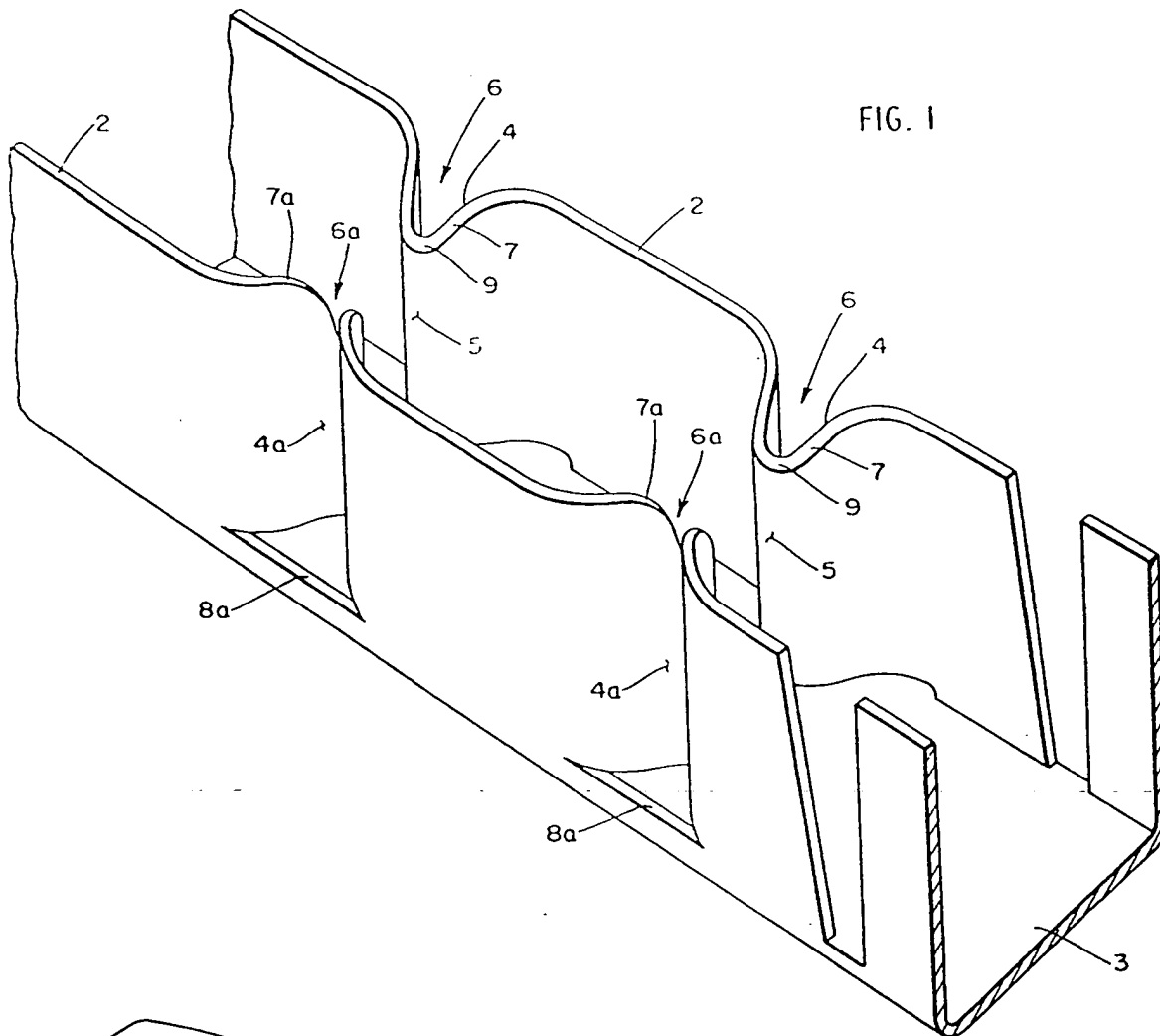


FIG. 2

